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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/855,281

Filing Date: May 15, 2001

Appellant(s): KOHDA ET AL.

Robert W. Griffith
(Registration # 48,956)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 18 August 2006 appealing from the Office action mailed 25 May 2006.

(1) Real Party in Interest

A statement identifying by name the real party of interest is contained in the appeal brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US 6,102,406	MILES ET AL.	8-2000
WO 00/41067	KAY ET AL.	7-2000

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 16, 17 and 20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
3. With respect to claims 16 and 17, the claimed invention is directed to non-statutory subject matter. The claim recites "...an object management means" which is not defined either in the claim or in the specification as including hardware. Thus, absent recitation of the

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server or some other hardware, claim 16 is not limited to tangible embodiments, instead being sufficiently broad to encompass software, per se. Claim 17 fails to add any additional structure to the system, instead merely further limiting the intended use of the system. Thus, it fails to overcome the deficiencies of claim 16.

4. With respect to claim 20, the language of the claim appears to be drawn to non-functional descriptive material. An “object” as recited in claim 20 is data, per se, lacking any functionality. Even if the object was amended to include functional code, claim 20 fails to tangibly embody the object, so it would still be non-statutory. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make it statutory. Such a result would exalt form over substance. In re Sarkar, 88 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978) (“[E]ach invention must be evaluated as claimed; yet semantogenic considerations preclude a determination based solely on words appearing in the claims. In the final analysis under 101, the claimed invention, as a whole, must be evaluated for what it is.”) (quoted with approval in Abele, 684 F.2d at 907, 214 USPQ at 687). See also In re Johnson, 589 F.2d 1070, 1077, 200 USPQ 199, 206 (CCPA 1978) (“form of the claim is often an exercise in drafting”). Thus, nonstatutory music is not a computer component and it does not become statutory by merely recording it on a compact disk. Protection for this type of work is provided under the copyright law. See MPEP § 2106 and the Interim Guidelines.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miles et al. (U.S. 6,102,406) in view of Kay (WO 00/41067).

Miles teaches the invention substantially as claimed including a new advertising model requiring a user to traverse through an authorized path including at least one predetermined web address (See Abstract, and col. 2, lines 5-10).

7. With respect to claim 1, Miles teaches a user guidance method performed on a computer comprising the steps of:

Incorporating an object into a specific web site at a specific location, where the object is capable of being selected by a user (Miles, col. 10, lines 45-49) in order to provide a reward for the user (Miles, col. 11, lines 1-5); where at least one user desiring to select the object is guided to predetermined content available at the specific web site (Miles, col. 3, lines 35-38).

Miles does not explicitly teach moving the object.

However, Kay teaches an object that appears on a web site that can be selected and takes the user from the specific location to a different location (Kay, page 3, line 25 – page 4, line 27).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Miles in view of Kay in order to enable movement of the object. One would be motivated to do so in order to advertise a product or service to a potential customer through a web browser.

8. With respect to claim 2, Miles teaches the invention described in claim 1, including the user guidance method where the step of moving the object comprises the step of:

Incorporating the object into the specific web site at the different location, after the object has been selected by the user (Miles, col. 10, line 64-col. 11, line 1).

9. With respect to claim 3, Miles teaches the invention described in claim 1, including the user guidance method further comprising the step of:

Providing information, after incorporating the object, concerning the location of the object for the at least one user desiring to select the object (Miles, col. 10, lines 5-8).

10. With respect to claim 4, Miles teaches the invention described in claim 1, including the user guidance method where at the step of moving the object, the user is moved along a predetermined route, and the at least one user desiring to select the object is guided to predetermined content in accordance with a specific order based on the route (Miles, col. 4, lines 48-57).

Miles does not explicitly teach moving the object.

However, Kay teaches an object that is moved (Kay, page 3, line 25 – page 4, line 27).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Miles in view of Kay in order to enable movement of the object. One would be motivated to do so in order to advertise a product or service to a potential customer through a web browser.

11. With respect to claim 5, Miles teaches the invention described in claim 1, including the user guidance method where at the step of incorporating the object, the object is incorporated at specific locations at multiple connected web sites across a network (Miles, col. 3, lines 26-31).

Miles does not explicitly teach moving the object.

However, Kay teaches where at the step of moving the object, the object is moved across the network (Kay, page 3, line 25 – page 4, line 27).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Miles in view of Kay in order to enable movement of the object. One would be motivated to do so in order to advertise a product or service to a potential customer through a web browser.

12. With respect to claim 6, Miles teaches the invention described in claim 5, including the user guidance method where at the user is moved along a predetermined route across the multiple web sites on the network (Miles, col. 4, lines 48-57), and the at least one user desiring to select the object is guided to predetermined content available in a specific sequential order based on the route (Miles, col. 4, lines 48-57).

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Miles does not explicitly teach moving the object.

However, Kay teaches where at the step of moving the object, the object is moved across multiple web sites on the network (Kay, page 3, line 25 – page 4, line 27).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Miles in view of Kay in order to enable movement of the object. One would be motivated to do so in order to advertise a product or service to a potential customer through a web browser.

13. With respect to claim 7, Miles teaches a computer-based content advertisement method comprising the steps of:

Incorporating an object into a network among content multiple users desire to browse, where the object is capable of being selected by a user (Miles, col. 10, lines 45-49) in order to provide a reward for the user (Miles, col. 11, lines 1-5), and when a predetermined user browsers the content, where a user desiring to select the object, is guided to and enabled to browse the content and additional content (Miles, col. 10, lines 24-27).

Miles does not explicitly teach moving the object.

However, Kay teaches moving the object in the network among additional content multiple users desire to browse (Kay, page 3, line 25 – page 4, line 27).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Miles in view of Kay in order to enable movement of the object. One would be motivated to do so in order to advertise a product or service to a potential customer through a web browser.

14. With respect to claim 8, Miles teaches the invention described in claim 7, including the content advertising method (Miles, col. 1, lines 43-45) where incorporating an object into a network among content multiple users desire to browse, where the object is capable of being selected by a user (Miles, col. 10, lines 45-49).

Miles does not explicitly teach moving the object.

However, Kay teaches where at the step of moving the object, movement of the object is effected along a route that includes the content multiple users desire to browse (Kay, page 3, line 25 – page 4, line 27).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Miles in view of Kay in order to enable movement of the object. One would be motivated to do so in order to advertise a product or service to a potential customer through a web browser.

15. With respect to claim 9, Miles teaches a computer-based user guidance system comprising:

A server comprising: an object manager for managing the location and movement of an object on a network (Miles, col. 13, lines 36-46); a position information generator for generating information concerning the location of the object, and for providing the information to a user who is accessing the network (Miles, col. 10, lines 5-8); and a processor for, when the object is selected by a predetermined user (Miles, col. 11, lines 1-5), performing a predetermined process associated with the object selection, where the object

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manager arranges the object at a desired location in order to guide the user to desired content on the network (Miles, col. 10, lines 14-49).

16. With respect to claim 10, Miles teaches the invention described in claim 9, including the user guidance system where, when the object is selected, the processor transmits a notification to that effect to the object manager, and upon the receipt of the notification (Miles, col. 10, line 64 – col. 11, line 1).

Miles does not teach deletion and repositioning of another object.

However, Kay teaches the object manager deletes the object selected by the user, and positions another object at a different location on the network (Kay, page 3, line 25 – page 4, line 27).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Miles in view of Kay in order to enable movement of the object. One would be motivated to do so in order to advertise a product or service to a potential customer through a web browser.

17. With respect to claim 11, Miles teaches the invention described in claim 9, including the user guidance system where, when the object is selected by a specific user, the processor transmits, together with information concerning the specific user, a notification to that effect to the object manager; where, upon the receipt of the notification, the object manager manages the information concerning the specific user, who is regarded as the person who has selected the object (Miles, Fig. 5, element 32; col. 10, line 64 – col. 11, line 1); where, if the

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object is selected by multiple users, only the specific user is regarded as the person who has selected the object (Miles, col. 12, lines 30-35).

18. With respect to claim 12, Miles teaches a computer-based object control system comprising:

Web servers, for storing web pages (Miles, Fig. 3, element 26); and a main server, for communicating with a predetermined web server (Miles, Fig. 3, element 20).

Miles does not explicitly teach moving the object.

However, Kay teaches where the main server incorporates a specific object into a first specific web page and removes the specific object from a second specific web page stored in the specific web server (Kay, page 3, line 25 – page 4, line 27).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Miles in view of Kay in order to enable movement of the object. One would be motivated to do so in order to advertise a product or service to a potential customer through a web browser.

19. With respect to claim 13, Miles teaches the invention described in claim 12, including the object control system where the object is selected when the object is present in a web page that a user is currently browsing (Miles, col. 10, lines 45-49); and where, when the object is selected by the user (Miles, col. 11, lines 1-5).

Miles does not teach deletion and repositioning of another object.

However, Kay teaches the main server deletes the object from the web page and incorporates the object into another web page (Kay, page 3, line 25 – page 4, line 27).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Miles in view of Kay in order to enable movement of the object. One would be motivated to do so in order to advertise a product or service to a potential customer through a web browser.

20. With respect to claim 14, Miles teaches the invention described in claim 12, including the object control system where the main server provides, for the user who accesses the specific web server, information concerning the location of the object that is appearing (Miles, col. 10, lines 5-8).

21. With respect to claim 15, Miles teaches the invention described in claim 14, including the object control system where the information concerning the location of the object, which is provided for the user, indicates the ease with which the object can be reached from the web page browsed by the user (Miles, col. 15, lines 59-61).

22. With respect to claim 16, Miles teaches an object control system of a computer comprising:

An object management means for managing the location of the object on the network, where the object management means changes the location of the object on the network in order to move the object across the network (Miles, col. 13, lines 36-46).

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Miles does not explicitly teach embedding the object into a web page.

However, Kay teaches an object to be embedded in a web page stored at a web site on a network (Kay, page 4, lines 22-24).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Miles in view of Kay in order to enable embedding the object into a web page. One would be motivated to do so in order to facilitate promoting purchases from an Internet web site.

23. With respect to claim 17, Miles teaches the invention described in claim 16, including the object control system where the object management means correlates the location of the object with a web page browsed by a predetermined user, and changes the location of the object when web pages are browsed by the predetermined user (Miles, Fig. 5, element 32; col. 10, line 64 – col. 11, line 1).

24. With respect to claim 18, Miles teaches a computer-based object control system comprising:

An object stored in a predetermined server (Miles, Fig. 5, element 36); and object position management means, for determining a web page for setting a link thereto, where, under the control of the object position management means the link setting means changes a target web page for setting a link thereto (Miles, col. 13, lines 36-46).

Miles does not explicitly teach moving the object.

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However, Kay teaches link setting means, for setting a link in a web page stored at a web site on the network in order to move to the object (Kay, page 3, line 25 – page 4, line 27).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Miles in view of Kay in order to enable movement of the object. One would be motivated to do so in order to advertise a product or service to a potential customer through a web browser.

25. With respect to claim 19, Miles teaches the invention described in claim 18, including the object control system where the object position management means defines a web page browsed by a predetermined user as the target web page to which the link with the object is to be set, and changes the target web page as the predetermined user browses the web pages; and where the link setting means, under the control of the object position management means, changes the link with the object (Miles, col. 10, line 45 – col. 11, line 1).

26. With respect to claim 20, Miles teaches an object whose location on the network is managed by specific management means, and which moves from a predetermined web page to another web page, where the object is capable of being selected by a user (Miles, col. 10, line 45 – col. 11, line 1) in order to provide a reward for the user (Miles, col. 11, lines 1-5).

Miles does not explicitly teach moving the object.

However, Kay teaches a moving object (Kay, page 3, line 25 – page 4, line 18), to be embedded in a web page stored at a web site on a network (Kay, page 4, lines 22-24).

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Miles in view of Kay in order to enable movement of the object. One would be motivated to do so in order to advertise a product or service to a potential customer through a web browser.

27. With respect to claim 21, Miles teaches a storage medium on which input means of a computer stores a program in an input-enabled form, the program causing the computer to perform:

A process for incorporating a specific object into a specific web page stored in a specific web server; a process for, when a user browses the specific web page and selects the specific object (Miles, col. 10, line 64-col. 11, line 1).

Miles does not explicitly teach moving the object.

However, Kay teaches moving the object to another web page (Kay, page 3, line 25 – page 4, line 18).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Miles in view of Kay in order to enable movement of the object. One would be motivated to do so in order to advertise a product or service to a potential customer through a web browser.

28. With respect to claim 22, Miles teaches a program transmission apparatus comprising:

Storage means for storing a program that causes a computer to perform: a process for incorporating a specific object into a specific web page stored in a specific web server, a

process for, when a user browses the specific web page and selects the specific object and transmission means for reading the program from the storage means and for transmitting the program (Miles, col. 10, line 64-col. 11, line 1).

Miles does not explicitly teach moving the object.

However, Kay teaches moving the object to another web page (Kay, page 3, line 25 – page 4, line 18).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Miles in view of Kay in order to enable movement of the object. One would be motivated to do so in order to advertise a product or service to a potential customer through a web browser.

(10) Response to Argument

The examiner summarizes the various points raised by the appellant and addresses them individually.

(A) *Appellant argues:* Appellants assert that the Examiner has failed to adequately explain how one would arrive at a conclusion of “software per se” for these claims, and further why software would be considered non-statutory subject matter.

In Response: The examiner respectfully submits that with respect to claims 16 and 17, the claimed invention is directed to non-statutory subject matter. The claims state “an object control system of a computer” and “object management means,” respectively. The use of the

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phrase "of a computer" does not necessarily impart any ability to a computer, but merely states that the object control system is a data structure. "Object management means" conveys a similar meaning. Thus, absent a recitation of the server or some other hardware that enables the system to execute instructions or code, claim 16 is not limited to tangible embodiments, instead being sufficiently broad to encompass software, per se. Claim 17 fails to add any additional structure to the system, instead merely further limiting the intended use of the system. Thus, it fails to overcome the deficiencies of claim 16.

"Data Structures" Representing Descriptive Material Per Se or Computer Programs Representing Computer Listings Per Se Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

Similarly, computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer

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program and other claimed elements of a computer which permit the computer program's functionality to be realized. See MPEP § 2106 and the Interim Guidelines.

With respect to claim 20, the language of the claim appears to be drawn to non-functional descriptive material. An "object" as recited in claim 20 is data, per se, lacking any functionality. Even if the object was amended to include functional code, claim 20 fails to tangibly embody the object, so it would still be non-statutory. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make it statutory. Such a result would exalt form over substance. In *re Sarkar*, 88 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978) ("[E]ach invention must be evaluated as claimed; yet semantogenic considerations preclude a determination based solely on words appearing in the claims. In the final analysis under 101, the claimed invention, as a whole, must be evaluated for what it is.") (quoted with approval in *Abele*, 684 F.2d at 907, 214 USPQ at 687). See also *In re Johnson*, 589 F.2d 1070, 1077, 200 USPQ 199, 206 (CCPA 1978) ("form of the claim is often an exercise in drafting"). Thus, nonstatutory music is not a computer component and it does not become statutory by merely recording it on a compact disk. Protection for this type of work is provided under the copyright law. Descriptive material that cannot exhibit any functional interrelationship with the way in which computing processes are performed does not constitute a statutory process, machine, manufacture or composition of matter and should be rejected under 35 U.S.C. 101. See MPEP § 2106 and the Interim Guidelines.

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(B) Appellant argues: Appellants submit that the statement above is based on the type of “subjective belief and unknown authority” that the Federal Circuit has indicated provides insufficient support for an obviousness rejection. More specifically, the Examiner fails to identify any objective evidence of record which supports the proposed combination.

In Response: The examiner respectfully submits that the motivation statement provided in previous Office Actions of “one would be motivated to do so in order to advertise a product or service to a potential customer through a web browser” can be found in the Kay reference on page 3, lines 25-28 (“These and other objectives are obtained by the present invention which contemplates a method for promoting purchases from an Internet web site. The methods includes the step of advertising product or service information on at least one merchant web page accessible to a potential customer through a web browser over a network line.”).

(C) Appellant argues: Kay states that one would be motivated to advertise a product or service to a potential customer through a web browser. However, in the final Office Action, Kay is used by the Examiner to modify Miles for the purpose of object movement. There is no evidence in Kay of object movement nor is there evidence that any such object movement advertises a product or service to a potential customer. Further, there is no evidence in Miles that such movement would be useful in the scavenger hunt advertising scheme.

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In Response: The examiner respectfully submits that in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

(D) ***Appellant argues:*** With respect to claims 1-8, the description of one or more links on a single web page fails to provide any description or suggestion that the hyperlink moves. Therefore, Kay fails to remedy the deficiencies described above with regard to Miles, and the combination of Miles and Kay also fails to disclose the moving of the object as recited in independent claims 1 and 7.

In Response: The examiner respectfully submits that Kay teaches an object that appears on a website that can be selected (overlaying on a web page, a button icon which is adapted to be activated by the customer when the customer desires to purchase a product or service) and takes the user from the specific location to a different location (when activated, the button icon will send the customer via a link to a separate page or window where an order form will be provided on which the customer indicates or confirms the product or service to be ordered – see Kay, page 3, line 25 – page 4, line 27 and the button icon may be implanted or overlayed on the web page at a single location, or at a plurality of locations – see Kay, page 4, lines 22-24).

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(E) Appellant argues: The combination of Miles and Kay fails to disclose an object manager that manages the location and movement of an object on a network and arranges the object at a desired location to guide the user to the desired content on the network, as described above with regard to claim 1.

In Response: The examiner respectfully submits that Miles teaches an object manager for managing the location and movement of an object on a network (this table may include the URL of at least the first Web site where the first game question/clue set (and possibly answer) can be found. This table can be expanded with additional URL locations as needed by the game – see Miles, col. 13, lines 36-46), where the object manager arranges the object at a desired location in order to guide the user to desired content on the network (for example, in one embodiment the introductory question/clue set for a game may inform the participants that the question will be related in some way to a particular book (identified in a clever way, perhaps not readily apparent to all participants... By visiting the Amazon.com Web site and searching for the subject book, the participants are required to become familiar with that site in an effort to locate the answer... Then, by clicking on a hidden (or not) hyperlink on that page of the Amazon.com site (e.g., a hyperlink hidden behind an image of the subject book or perhaps prominently displayed on the page if the advertiser so chooses) the participant is returned to the game site – see Miles, col. 10, lines 14-49).

(F) *Appellant argues:* The combination of Miles and Kay fails to disclose a main server that incorporates the object into a first web page and removes the object from a second web page.

In Response: The examiner respectfully submits that Kay teaches a main server incorporates a specific object into a first specific web page (overlaying on a web page, a button icon which is adapted to be activated by the customer when the customer desires to purchase a product or service) and removes the object from a second web page (when activated, the button icon will send the customer via a link to a separate page or window where an order form will be provided on which the customer indicates or confirms the product or service to be ordered – see Kay, page 3, line 25 – page 4, line 27). There is no mention in the reference that the icon appears on this second web page. Office personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003) (claims must be interpreted “in view of the specification” without importing limitations from the specification into the claims unnecessarily). *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969). See also *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (“During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow.... The reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed.... An essential purpose of patent examination is to fashion claims

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that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.”).

(G) Appellant argues: The combination of Miles and Kay fails to disclose that the information concerning the location of the object, which is provided for the user, indicates the ease of which the object can be reached from the web page browsed by the user.

In Response: The examiner respectfully submits that the combination of Miles and Kay teaches the incorporation of the object into the specific web site at a different location after the object has been selected by the user (by clicking a hidden (or not) hyperlink on that page of the Amazon.com site (e.g., a hyperlink hidden behind an image of the subject book or perhaps prominently displayed on the page if the advertiser so chooses) the participant is returned to the game site...If the participant submits the correct response, he or she is presented with the next answer/clue set and the process repeats – see Miles, col. 10 line 45 – col. 11, line 1). Further, the combination of Miles and Kay teaches the information concerning the location of the object, which is provided for the user, indicates the ease of which the object can be reached from the web page browsed by the user (the game’s degree of difficulty can be increased or decreased in by providing harder or easier clues – see Miles, col. 15, lines 59-61).

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(H) Appellant argues: The combination of Miles and Kay fails to disclose the changing of the location of the object on the network in order to move the object across the network, as described with regard to claim 1.

In Response: The examiner respectfully submits that Miles teaches changing the location of the object on the network in order to move the object across the network (for example, in one embodiment the introductory question/clue set for a game may inform the participants that the question will be related in some way to a particular book (identified in a clever way, perhaps not readily apparent to all participants...By visiting the Amazon.com Web site and searching for the subject book, the participants are required to become familiar with that site in an effort to locate the answer...Then, by clicking on a hidden (or not) hyperlink on that page of the Amazon.com site (e.g., a hyperlink hidden behind an image of the subject book or perhaps prominently displayed on the page if the advertiser so chooses) the participant is returned to the game site – see Miles, col. 10, lines 14-49).

(I) Appellant argues: The combination of Miles and Kay fails to disclose an object, capable of being selected by the user in order to provide a reward for the user, which moves from a predetermined web page to another web page, as described above in regard to claim 1.

In Response: The examiner respectfully submits that the combination of Miles and Kay teaches an object, capable of being selected by the user (by clicking a hidden (or not) hyperlink

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on that page of the Amazon.com site (e.g., a hyperlink hidden behind an image of the subject book or perhaps prominently displayed on the page if the advertiser so chooses) the participant is returned to the game site – see Miles, col. 10, lines 45-49) in order to provide a reward for the user (this sort of dialog can continue until all of the questions for a particular game have been answered, at which time a participant may be congratulated for his/her efforts and perhaps later notified (e.g., by electronic mail) at a later time of any prizes won – see Miles, col. 11, lines 1-5), which moves from a predetermined web page to another web page (the button icon may be implanted or overlayed on the web page at a single location, or at a plurality of locations – see Kay, page 3, line 25 – page 4, line 27).


For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,

Alicia Baturay **AB**

26 October 2006

Conferees:


SALEH NAJJAR
SUPERVISORY PATENT EXAMINER


BHARAT BAROT
PRIMARY EXAMINER

Day : Thursday
Date: 07-Dec-
2006
Time: 13:38

SIRDEV MIS INTRANET

APPEAL CENTER RETURN

Application Number: 09855281

Date: 07-DEC-06

Examiner: ALICIA, BATURAY

GAU: 2155

Appeal Document(s) that caused this Return

* Examiner's Answer

Reason for Return (from Appeal Specialist to Examiner)

The Examiners Answer dtd 11/03/06 does not contain the references used to reject the claims under appeal in section 8 Evidence Relied Upon. Also the Examiners full name is needed along with his initials or signature.
Everett Wms x2-3619

Corrected

RESPONSE (by Examiner)

After correcting noted items (above) that require paper to be sent to the Appellant, please click here: then forward the appropriate documents for mailing and scanning, per TC procedures.

After correcting noted items (above) that do not require paper to be sent to the Appellant, please click here: to close the website.

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